

Appl. No. 10/827029

REMARKS

The following remarks are in response to the Office Action mailed on August 23, 2005. Upon entrance of the amendments set out above, claims 20-26 remain pending in this application.

The Examiner requested that a CROSS-REFERENCE TO RELATED APPLICATIONS section be added. The Examiner rejected claims 20-26 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 6,519,922. Claims 20-26 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 20-26 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 20-23, 25 and 26 were rejected under 35 U.S.C. 102(b) as being anticipated by Hirsh et al. (WO 98142576). Response is hereby made to these rejections. Each will be addressed in detail below.

Claim 24 was indicated as being allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The Applicants thank the Examiner for the indication of allowable subject matter.

The Examiner requested that a CROSS-REFERENCE TO RELATED APPLICATIONS section be added. This section was added by preliminary amendment and is, to Applicants' knowledge, current. The section has been reproduced above, for the Examiner's convenience.

The Examiner rejected claims 20-26 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 6,519,922. A

Appl. No. 10/827029

terminal disclaimer is provided herewith. Accordingly, this rejection has been overcome.

Claims 20-26 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement because claim 20, lines 12-16, include the term "passive device" and its function. The examiner correctly noted that the term is not stated in the original specification, and held it was not clear what is the "passive device."

Passive device is simply a device that is passive. Passive has the ordinary dictionary meaning -- not active. An active device is one that provides energy -- such as a motor, spring, etc. A passive device is simply a device that is acted upon, not one that is active.

The specification discloses a passive device -- a tracer pin. While the specification does not call out the passive nature of the pin, one skilled in the art will readily recognize that it is passive, it is not an active device like a spring, or motor. Thus, this invention was in the possession of the inventor, at the time of the invention, and is described in the specification. Accordingly, this rejection should be withdrawn.

Claims 20-26 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for a number of reasons. Each will be addressed.

Claims 20-26 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because the Examiner held the term "passive device" in claim 20, lines 12-16, vague and indefinite.

As stated above the term passive device means a device that is not active -- one that does not add energy. The

Appl. No. 10/827029

preferred embodiment shows an example of a passive device -- a tracer pin. Thus, this rejection should be withdrawn.

Claims 20-26 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite because the term "tool carrier" was inappropriately used in claim 20, line 13. The Examiner correctly pointed out it should be "tool mount", and claim 20 has been so amended. Accordingly, this rejection has been overcome.

Claims 20 and 25 were held vague and indefinite because the Examiner further held the phrase "the passive device affects the path . . . the selected pair follows" was unclear and confusing. Claim 20 has been amended to remove a confusing and incorrect words "a pair of". The amended complete phrase is:

the passive device affects the path of a selected pair of the first and second pairs of tools mounted on the carrier such that the distal end of the selected pair follows...

Applicants respectfully submit this language is not vague or indefinite. Specifically, the passive device (a tracer pin in the preferred embodiment) affects the path of one of the tools pairs (the stripper in the preferred embodiment) such that the distal end of the selected tools follows the desired path. Accordingly, this rejection should be withdrawn.

Applicants note that while they have provided reference to an example -- the preferred embodiment -- the claims are not limited to the specific embodiment shown.

The Examiner held that the phrase "the near end of line 16, claim 20 lacked antecedent basis. Claim 20 recites a near end at line 6. Accordingly, this rejection should be withdrawn.

Claims 20-23, 25 and 26 were rejected under 35 U.S.C. 102(b) as being anticipated by Hirsh et al. (WO 98142576).

Appl. No. 10/827029

The Examiner held the Hirsh et al. reference disclosed, *inter alia*, that the passive devices (58) of Hirsch were mounted near the distal end of the each tool mounts

As set forth in claim 20, the tool mount defines the near and distal ends. The near end is the end where motion is imparted -- i.e., attached to a motor arm, and the distal end the opposite end.. The passive device, in the claimed invention, causes "the distal end" to follows "a path parallel to a path the near end" follows. Thus the distal and the near end of the tool follow parallel paths.

The near and distal ends of the tools in Hirsch would be in a direction perpendicular to the plane of the paper. Nothing in Hirsch suggests that 58 causes anything to follow parallel paths, much less near and distal ends of a pair of tools. The groove may dictate a path for one end (its not clear if it is the near or distal end), but nothing suggest it is parallel to the opposite end. Accordingly, this rejection should be withdrawn.

Accordingly, in view of the above amendments and remarks, Applicants respectfully submit that the application should be allowed. The Examiner is invited to telephone the undersigned below if it will aid in the prosecution of this application.

Respectfully Submitted



George R. Corrigan, Reg. No. 34,803
Corrigan Law Office
5 Briarcliff Court
Appleton, WI 54915
(920) 954-1099